

Docket No.: 208937US0PCT

COMMISSIONER FOR PATENTS
ALEXANDRIA, VIRGINIA 22313



RE: Application Serial No.: 09/856,157
Applicants: Teruo HORIZUMI, et al.
Filing Date: June 1, 2001
For: SHEET COSMETICS
Group Art Unit: 1615
Examiner: HOWARD, S.

SIR:

Attached hereto for filing are the following papers:

APPEAL BRIEF

Our credit card payment form in the amount of **\$500.00** is attached covering any required fees. In the event any variance exists between the amount enclosed and the Patent Office charges for filing the above-noted documents, including any fees required under 37 C.F.R. 1.136 for any necessary Extension of Time to make the filing of the attached documents timely, please charge or credit the difference to our Deposit Account No. 15-0030. Further, if these papers are not considered timely filed, then a petition is hereby made under 37 C.F.R. 1.136 for the necessary extension of time. A duplicate copy of this sheet is enclosed.

Respectfully submitted,

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208937US0PCT

IN THE UNITED STATES PATENT & TRADEMARK OFFICE

IN RE APPLICATION OF: :
Teruo HORIZUMI, et al. : GROUP ART UNIT: 1615
SERIAL NO.: 09/856,157 : EXAMINER: HOWARD, S.
FILED: JUNE 1, 2001 :
RCE Filed March 23, 2004
FOR: SHEET COSMETICS :

APPEAL BRIEF

COMMISSIONER FOR PATENTS
ALEXANDRIA, VIRGINIA 22313

SIR:

The following is an appeal of the examiner's final rejection of August 11, 2004 of claims 1, 2, 5-10 and 14-19 as obvious. A notice of appeal was filed on October 21, 2004.

(i) REAL PARTY IN INTEREST

The real party in interest is the Kao Corporation, by assignment recorded at reel/frame 012216/0498-0500.

(ii) RELATED APPEALS AND INTERFERENCES

Appellants, appellants' legal representative and the assignee are not aware of any related appeals, interferences or judicial proceedings which will directly affect or be directly affected, or have a bearing on the Board's decision in the pending appeal.

(iii) STATUS OF CLAIMS

Claims 1, 2, 5-10 and 14-19 are active in this application and are herein appealed.

Claims 3, 4 and 11-13 are canceled.

(iv) STATUS OF AMENDMENTS

No amendments have been filed subsequent to the final rejection from which appeal is taken.

(v) SUMMARY OF CLAIMED SUBJECT MATTER

The claimed subject matter is directed to a sheet cosmetic comprising a single-layered aqueous gel sheet having no supporting layer, wherein an aqueous gel sheet of 1 mm in thickness has a light transmittance of 70% or more wherein said aqueous gel sheet comprises an agar (A) which has a gel strength of 600 g/cm² or less at an agar content of 1.5 wt%, wherein said agar ingredient (A) is obtained by subjecting raw seaweed having a sulfate group content of 1-10% to extraction in neutral hot water (page 3, lines 1-4 and page 5, lines 20-24).

Supported gel sheets have been used to deliver active ingredients such as a humectant or whitening agent to the skin. A supporting sheet has heretofore been employed to provide sufficient strength to the sheet cosmetic. Difficulties have been observed with such supported sheets in terms of the feel and appearance in use.

Appellants have discovered that a non-supported sheet prepared from agar obtained by hot aqueous extraction of raw seaweed having a sulfate content of 1-10% may be

advantageously used as a sheet cosmetic as it is possessed of suitable strength, adhesiveness, transparency and feel in use.

Such a sheet comprising agar as claimed, which has no supporting layer is nowhere disclosed or suggested in the references relied upon by the examiner.

(v) GROUND OF REJECTION TO BE REVIEWED ON APPEAL

Whether claims 1, 2, 5-10 and 14-19 are obvious under 35 U.S.C. § 103(a) over JP 8-188,527 (hereinafter JP '527)?

(vii) ARGUMENTS

The examiner has committed reversible error in concluding the claims to be obvious over JP '527 as the reference fails to describe the claim limitations of an agar as claimed and fails to describe the absence of a support layer, as claimed.

JP '527 describes a sheet-like pack used for skin regulation and cosmetic (page 5 [0001] of English language translation). The sheet pack agent contains a water soluble polymer, a polyhydric alcohol, a moisture-keeping agent, a crosslinking component, a beautiful skin component and water (see paragraph [0005]). The reference describes that the pack agent layer is provided on a base fabric, such as synthetic resin films, non-woven fabrics, and non-woven paper (page 21 [0019] of English language translation). At page 22, [0020] is a description of forming the pack agent by spreading on the base fabric. Each of examples 1-19 and comparative examples 1-5, exemplify a pack formed on a base fabric. A base fabric is a supporting layer. The sheet-like pack of JP '527 has a supporting layer. None of these components disclose or suggest an agar as claimed or the absence of a supporting layer.

JP '527 fails to describe a cosmetic sheet comprising an agar having a gel strength of 600 g/cm² or less, and which is obtained by subjecting raw seaweed having a sulfate group content of 1-10% to extraction in neutral hot water

The sheet pack agent is identified as containing a water soluble polymer, a polyhydric alcohol, a moisture-keeping agent, a crosslinking component, a beautiful skin component and water (see paragraph [0005]). None of these components suggest forming a sheet of agar as claimed.

The water soluble polymer is described in paragraph [0006] as gelatin or a polyacrylate. There is no disclosure or suggestion of an agar as claimed.

The polyhydric alcohol is described at paragraph [0007] as a polyhydric alcohol and glycols. There is no disclosure or suggestion of an agar as claimed.

The moisture-keeping agent is described at paragraph [0008] as acylation Kefiran aqueous solution. There is no disclosure or suggestion of an agar as claimed.

The crosslinking component is described at paragraph [0009] as a poor-water solubility aluminum compound and a polyfunctional epoxy compound. There is no disclosure or suggestion of an agar as claimed.

The beautiful skin component is described in paragraph [0010]. There is no disclosure or suggestion of an agar as claimed.

The water component is described in paragraph [0011]. There is no disclosure or suggestion of an agar as claimed.

An antiseptic component is described in paragraph [0012]. There is no disclosure or suggestion of an agar as claimed.

Antioxidant, tackifier and solubilizer components are described in paragraph [0014]. As a tackifier, agar is described as one of many possible materials, but there is no disclosure

or suggestion of an agar **as claimed**. Moreover, the agar is not used for gelatinizing as other tackifier components such as starch and dextrin do not have a gelatinizing effect.

In contrast, the present invention is directed to a sheet cosmetic comprising a single-layered aqueous gel sheet comprising an agar having a gel strength of 600 g/cm² or less, and which is obtained by subjecting raw seaweed having a sulfate group content of 1-10% to extraction in neutral hot water. Such an agar is described in JP 10-309,182. As the cited reference fails to disclose or suggest a sheet cosmetic comprising an agar having a gel strength of 600 g/cm² or less, and which is obtained by subjecting raw seaweed having a sulfate group content of 1-10% to extraction in neutral hot water, the claimed invention is simply not rendered obvious by the cited reference.

To establish *prima facie* obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. *In re Royka*, 490 F2d. 981,180 USPQ 580 (CCPA 1974))

As the cited reference fails to disclose or suggest the claim limitation of an agar having a gel strength of 600 g/cm² or less, and which is obtained by subjecting raw seaweed having a sulfate group content of 1-10% to extraction in neutral hot water, the present invention is clearly not *prima facie* obvious over the cited reference. The examiner has committed reversible error in concluding the claimed invention to be obvious, when the reference fails to identify the claim limitation of an agar having a gel strength of 600 g/cm² or less, and which is obtained by subjecting raw seaweed having a sulfate group content of 1-10% to extraction in neutral hot water. For at least this reason the decision of the primary examiner must be reversed.

JP '527 fails to describe a cosmetic sheet comprising a single-layered aqueous gel sheet having no supporting layer.

JP '527 describes a sheet-like pack used for skin regulation and cosmetic (page 5 [0001] of English language translation). The reference clearly teaches the presence of a supporting layer (page 21, paragraph [0019]) and therefore fails to disclose or suggest a cosmetic sheet having no supporting layer.

In contrast the present invention is directed to a sheet cosmetic comprising a single-layered aqueous gel sheet having no supporting layer. The claim limitation of "no supporting layer" is not found in the cited reference as mentioned above. Because the claim limitation of no supporting layer is not found in the cited reference, the claimed invention is simply not made obvious from the reference.

As the cited reference fails to disclose or suggest the claim limitation of no supporting layer, the present invention is clearly not *prima facie* obvious over the cited reference.

In response to appellants' arguments, the examiner has cited to section [0019] of the reference at page 21/45, that with respect to the base fabric "it can choose suitable". The inference asserted by the use of the verb "can" is that the use of a support layer is optional. Appellants respectfully submit that it is the selection of the specific base fabric which is optional, not the use of a base fabric. Appellants further note that the next paragraph in section [0019] states that the pack agent layer is provided on the base fabric. Such a statement makes clear that the base fabric is essential to the sheet pack of the reference.

Moreover, JP '527 makes no reference whatsoever to the pack agent being in the form of a sheet, except in the context of being deposited as a layer on a base fabric. There is no disclosure of formation of a separate layer of pack agent. Prior to being deposited on the surface of the base fabric, the pack agent merely exists as a mass of undefined, without a sheet structure. It is the association with the base fabric which confers a sheet structure to the

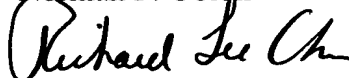
pack of the reference. As such, while the reference describes a gel sheet in the presence of a supporting layer, there is no suggestion of a gel sheet in the absence of a supporting layer. In the absence of the supporting layer, there is no suggestion of a sheet structure.

The cited reference fails to disclose all of the elements of the claimed invention and therefore, the claimed invention is certainly not rendered obvious by this reference. The examiner has committed reversible error in concluding the claimed invention to be obvious, when the reference fails to identify the claim limitation of having no supporting layer. For at least this reason the decision of the primary examiner must be reversed.

Appellants submit that in view of the deficiencies noted above, the decision of the primary examiner must be reversed.

Respectfully submitted,

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(ix) CLAIMS APPENDIX

1. A sheet cosmetic comprising a single-layered aqueous gel sheet having no supporting layer, wherein an aqueous gel sheet of 1 mm in thickness has a light transmittance of 70% or more

wherein said aqueous gel sheet comprises an agar (A) which has a gel strength of 600 g/cm² or less at an agar content of 1.5 wt%, wherein said agar ingredient (A) is obtained by subjecting raw seaweed having a sulfate group content of 1-10% to extraction in neutral hot water.

2. A sheet cosmetic according to claim 1, having an adhesion force 1-100 time its own weight.

5. A sheet cosmetic according to claim 1, further comprising an additional water-soluble polymer (B).

6. A sheet cosmetic according to claim 1, further comprising a humectant (C).

7. The sheet cosmetic of claim 1, wherein said light transmittance is 80% or more.

8. The sheet cosmetic of claim 1, wherein said light transmittance is 85% or more.

9. The sheet cosmetic of claim 1, having an adhesion force 1-90 times its own weight.

10. The sheet cosmetic of claim 1, having an adhesion force 1-50 times its own weight.

14. The sheet cosmetic of claim 5, wherein said water-soluble polymer is present in an amount of 0.001 to 50 wt.%.

15. The sheet cosmetic of claim 5, wherein said water-soluble polymer is present in an amount of 0.01 to 10 wt.%.

16. The sheet cosmetic of claim 6, wherein said humectant is present in an amount of 0.001 to 40 wt.%.

17. The sheet cosmetic of claim 6, wherein said humectant is present in an amount of 0.01 to 30 wt.%.

18. The sheet cosmetic of claim 1, having a thickness of 0.1 to 5 mm.

19. The sheet cosmetic of claim 1, having a thickness of 0.5 to 2 mm.